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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Appln. of: Robert Filepp et al. Group Art Unit: 2301

Serial No.: 08/158,031 Examiner: H. R. Herndon

Filed: November 26, 1993

Title: METHOD FOR PRESENTING APPLICATIONS IN AN INTERACTIVE SERVICE

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AMENDMENT

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

In response to the Official Action dated April 21, 1994, Applicants request the following amendment be entered in their application, and that their application be reconsidered in light of those amendment and the related remarks presented below.

In the Abstract:

Rewrite the Abstract as Follows:

A method for presenting applications in an interactive service (is described. The method features) featuring steps for generating (a) screen displays of the service applications at the reception systems of the respective users. (respective reception systems provided in a computer network on which the services is provided for user interaction. In accord with the method, steps) Steps are (included) provided for generating (a plurality of) the application displays as screens having a plurality of partitions, (in which at least a user-requested application is concurrently presented with a group of) the partitions being

constructed from reusable elements. In accord with the method, the screens include at least a first partition at which an application may be presented and a second, concurrently displayed partition including command functions for managing the display. The method further (features) includes steps for providing (the) command functions (group with a subgroup of functions) that facilitate random navigation to new applications(, employing) with a variety of different procedures (of the user's selection) which the user can choose from. In (preferred) one form, the functions are presented as a command bar located at (a fixed region of) the bottom of the screen. (As well) Further, the method includes steps for opening and closing windows on the display to enable presentation of additional data relating to the presented applications. Still further, the method includes steps for providing additional partitions for concurrently displaying other applications, which may include advertising.

In the Drawings:

Applicants request that the Examiner approve the amendment to Fig. 1 shown in red ink on the accompanying drawing sheet.

In the Specification:

At page 2, line 5, after "issued", delete "January" and insert --September 13--;

At page 2, line 6, beginning, insert --5,347,632--;

At page 6, line 24, after "be", insert --concurrently--;

At page 8, line 25, beginning, delete "or" and insert --of--:

At page 24, line 31, after "patent", insert --5,347,632--;

At page 25, line 31, after "patent", insert --5,347,632--;

At page 27, line 27, after "patent", insert --5,347,632--;

At page 59, line 34, after "patent", insert --5,347,632--;

In the Claims:

1. (Amended) A method for presenting applications of an interactive service provided on a computer network, the network including a multiplicity of user reception systems at which respective users may request a multiplicity of available service applications, the respective reception systems including a monitor at which the applications requested can be presented as one or more screens of display, the method comprising the steps of:

a. generating a screen display at the respective reception systems that includes a plurality of partitions, the partitions being constructed from elements that may be reused;

b. generating at least a first partition for presenting applications; and

c. generating concurrently with the first partition at least a second partition for presenting a (group) plurality of command functions, the command(s of the) functions including at least a first group (being) which are selectable to manipulate the (screen) display of applications.

2. (Amended) The method of claim 1 wherein the elements for constructing the partitions are objects and wherein generating the second partition includes providing the first group of command functions with a first subgroup of command functions which are selectable to randomly moving between available applications.

3. (Amended) The method of claim 2 wherein providing the first subgroup of command functions includes providing a command for causing the user to be presented with at least one procedures for navigating to a new application.

4. (Amended) The method of claim 2 wherein providing the first subgroup (group) of command functions includes providing at least one command for causing the user to be presented with a plurality of different procedures for navigating to a new application.

10. (Amended) The method of claim 2 wherein providing the (second group) first subgroup of command functions includes providing at a command for enabling the user to progress through a sequence of applications previously designated.

12. (Amended) The method of claim 1 further including generating at least a third screen partition concurrently with the first and second screen partitions for presenting a second application.

REMARKS

In the Official Action dated April 21, 1994, the Examiner objected to Applicants' abstract on the grounds that it was not in narrative form, and noted certain informalities in the specification and drawings. Additionally, the Examiner rejected Applicants' claims 1-17 under 35 U.S.C. §102(b) as anticipated by the publication *Mastering Windows™ 3.0*, by Robert Cowart, SYBEX, 1990 (Windows).

With regard to the Examiner's objection to Applicants' abstract, Applicants have undertaken amendments intended to provide the abstract with a more narrative form. Further, mindful of the Examiner's suggestion that the abstract be held to less that 250 words, Applicants' have restricted the length of the amended abstract to 170 words. Accordingly, Applicants would respectfully submit that the abstract is now in acceptable form.

Concerning the informalities, Applicants' have reviewed their specification and entered amendments to remove typographical errors and update the reference to their parent application which issued September 13, 1994, as U.S. patent 5,347,632. No new matter has been added.

Still further, as requested, Applicants' have proposed to amend Fig. 1 to indicate the reference to the Reception System Layer 401. The proposed amendment is shown in red ink on the accompanying copy of the drawing sheet for Fig. 1.

Turning to the Examiner's rejection of Applicants' claims. As noted, the Examiner rejected Applicants' claims 1-17 under 35

U.S.C. §102(b) as anticipated by the publication *Mastering Windows™ 3.0* by R. Cowart (Windows). Following a review of the publication and the Examiner's comments, Applicants would respectfully submit the rejection is improper both as a matter of fact and as a matter of law and, accordingly, must be withdrawn.

First, Applicants would point out that the publication date for the Windows piece is 1990 (editorial page proceeding Chapter 1 in the copy forwarded to Applicants with the April 21, 1994 Official Action). Further, as Applicants noted on page two of their specification, the current application is a divisional of their parent application S.N. 388,156, filed July 28, 1989, the subject matter of which was first disclosed in their great-grandparent application S.N. 219,931, filed July 15, 1988, now abandon.

Support for the subject matter of current application is found in the great-grandparent application at least at: pg. 8, ln. 3 - pg. 9, ln. 23; pg. 17, ln. 3 - pg. 18, ln. 23; pg. 20, ln. 1 - ln. 18; pg. 21, ln. 6 - pg. 25, ln. 3; pg. 28, ln. 22 - pg. 30, ln. 16; pg. 35, ln. 11 - pg. 39, ln. 12; and pg. 50, ln. 10 - pg. 57, ln. 9. Additionally, support may be found in Figs. 3a, 3b, 4d, 5a, 5b, 6, 9 and 10.

Additionally, support for the subject matter of the current application is also present in their parent application, now patent 5,347,632, at least at cl. 5, lns. 33 - 39; cl. 8, ln. 64 - cl. 9, ln. 57; cl. 10, ln. 30 - cl. 11, ln. 41; cl. 13, ln. 64 - cl. 14, ln. 27; cl. 16, ln. 21 - cl 17, ln. 2; cl. 73, ln. 46

- cl. 75, ln. 39; cl. 95, ln. 67 - cl. 98, ln. 66. As well, support may also be found at patent Figs. 3a, 3b, 4d, 5a, 5b, 6, 9, and 10.

Therefore, under 35 U.S.C. §120, §121 in accordance with which the current application was filed, the current application has an effective filing date of July 15, 1988. Further since 35 U.S.C. §102(b) provides:

> A person shall be entitled to a patent unless -
> ...
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States,
> ....

35 U.S.C. §102, (1975), the Examiner's rejection of Applicants' claims 1-17 is improper as a matter of law and must be with drawn.

Still further, Applicants' would respectfully point out, that even if an earlier reference for Microsoft Windows™ could be found, as a matter of technical fact, it could not anticipate Applicants' method. Windows is a shell environment for stand-alone DOS application and does not, on its own constitute a reception environment for an interactive service provided on a computer network as expressly provided in Applicants' claims.

Though Applicants' claims expressly refer to the interactive service and computer network in the their preambles, it has long been recognized that in the case where the preamble of a claim is fundamental to the interpretation of the claim as is the case here, it expressly act to distinguish the claim over

the art. And, this is exactly the rule the Court of Appeal for the Federal Circuit once again articulated in the recently issued *Paulsen* case. As noted by the Court:

> The preamble of a claim does not limit the scope of the claim when it merely states a purpose or intended use of the invention. *See DeGorge v. Bernier*, 768 F2.2d 1318, 1322 n.3, 226 USPQ 758, 761 n.3 (Fed. Cir. 1985). However, terms appearing in a preamble may be deemed limitations of a claim when they "give meaning to the claim and properly define the invention." *Gerber Garment Technology, Inc. v. Lectra Sys., Inc.*, 916 F.2d 683, 688, 16 USPQ2d 1436, 1441 (Fed. Cir. 1990) (quoting *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 896, 221 USPQ 669, 675 (Fed. Cir.), *cert. denied*, 469 U.S. 857 (1984) [emphasis added]

In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

As is clear from Applicants' specification, their method concerns presentation of interactive services on networks and not conventional DOS stand-alone applications. As noted in Applicants specification, their invention seeks to address problems of response time and user satisfaction in an on-line service. Accordingly, their method is intended to provide features such as reusability of partition elements which reduce line traffic and delay. None of these consideration are present in a Windows environment.

Accordingly, in view of the absence of fundamental elements of Applicants' claimed invention in the cited reference, it can not be said that their claims are anticipated. The Court of Appeals for the Federal Circuit (CAFC) and its predecessor, the Court of Customs and Patent Appeals (CCPA), have repeatedly held that for a prior art reference to anticipation a claimed

invention under 35 U.S.C. §102, each and ever element of the claimed invention must appear in the single reference. *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (Fed Cir 1988). Further, the CAFC has pointed out that the elements of the claimed invention must be arranged in the reference as they are in the claimed invention in order to establish an anticipation. *Lindemann Maschinefabrik v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed Cir 1984).

Therefore, because Windows either as described in the cited reference, which by its publication date is ineffective, or some other comparable, earlier reference that might be cited, fails to disclose or suggest use of concurrently created partition constructed from elements which may be reusable for the presentation of an interactive application provided on a computer network together with a command functions partition, it can not be said Applicants' claimed invention is anticipated. Accordingly, the Examiner's rejections of claims 1-17 as anticipated under 35 U.S.C. §102(b) is erroneous and must be withdrawn.

However, while Applicants believe their invention as claimed is distinguished over the art, in an effort to further clarify those distinctions and to move their application to allowance, Applicants have amended their claim 1 to point out that their partitions are constructed from elements which may be reused and that the first and screen partitions are concurrently presented at the display. Additionally, claim 2 has been amended to state that the partition elements are objects.

Support for the amendment of claim 1 can be found at least at pg. 2, lns. 18 - 27; pg. 9, ln. 32 - pg. 10, ln 25; pg. 11, ln. 18 - pg.12, ln. 2, and pg. 18, lns. 5 - 19. Finally, Applicants have entered various other editorial amendments to the claims in order to provide additional clarity of meaning.

Accordingly, in view of the noted amendments and preceding remarks, Applicants would respectfully submit that their invention is patentably distinguished from the art cited, and, that all objections raised by the examiner have been resolved. Therefore, Applicants, requests reconsideration of their application and issuance of a patent thereon.

Dated: October 21, 1994,

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231, on October 21, 1994.

Name of Registered Representative: Paul C. Scifo, Esq.

Signature:

Date: October 21, 1994